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REMARKS

Reconsideration of the above identified application is respectfully requested.

The specification has been amended at para. 21 to introduce the axis numeral 22 and conform with the figures and para. 26.

Claims 9 and 13 have been amended to correct spelling errors.

Applicant traverses the examiner's contentions in supporting the restriction requirement.

Firstly, the replacement examiner's belated attempt to add the "cutting with a laser" example to the previous restriction requirement made by the previous examiner is not found in that previous requirement and denies the Applicant due process in traversing that requirement.

How can Applicant traverse the requirement now when the present examiner has changed the grounds for the requirement, and at the same time made that requirement "final?"

And, the present examiner has provided neither logic nor evidence to support the bald contention that the diecuts expressly recited in the claims under restriction could have been made by "cutting with a laser," when that is an impossibility per se.

The present examiner merely continues to add to the growing errors, without regard to the level of skill in the art and without regard to simple logic.

Furthermore, the present examiner attempts to further bolster the previous restriction requirement by stating that a "full search of the method classification was not required to establish the patentability of the article claims."

Rule 104 mandates a thorough search and examination by the examiner, and does not recognize or support or authorize the use of restriction practice to avoid searching in every feasible search class in meeting that mandate for uncovering

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relevant prior art.

Indeed, the replacement examiner in this application having first confirmed the 428/137 search class for the Group I claims identified in the restriction requirement as a basis to support that restriction requirement has clearly not limited the prior art search to that class, but has instead searched far and wide to uncover the two references being applied from classes 428/593 and 271/1, which two references clearly do not anticipate any of the claims, and are clearly nonanalogous art.

The Group I stack is expressly recited in both sets of method of making and use claims found in Groups II and III; and the examiner uses the restriction practice as a rote expedient in disregard of the commonly recited stack.

It would appear that Rule 104 mandates searching by the examiner in the search classes for both Groups II & III since it is without a doubt likely that searching in a search class which contains patents for the method of making sheet stacks, would ipso facto uncover those very sheet stacks and their specific configurations.

Furthermore, searching in a search class which contains patents for the method of using sheet stacks would also, without any doubt, likely uncover those sheet stacks and their specific configurations.

And, as a matter of fact, the very recent experience of the present attorney in another stationery product application included claims drawn to the product and method of using the product, and also included a restriction requirement between product and method, with the product being similarly elected.

However, the most relevant references pertaining to the product were only uncovered by the examiner after multiple office actions and multiple search updates, and after RCE, in search classes, not directed to the product itself, but in different search classes specifically relevant to business

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method of use of the product.

Therefore, Applicant continues to traverse the restriction requirement, and the examiner's basis therefor based on different search classes; and hereby requests that even the identified classes for the Group II & III claims, as well as any other search class be searched in an updated search in accordance with the thoroughness standard of Rule 104.

The intentional failure of the examiner to search those additional search classes cannot be condoned under Rule 104, which preempts the MPEP, irrespective of any "burden" to conduct the requisite search in the patent system, whatever that search might entail.

In view of the clear patentable novelty of the product claims, rejoinder of the method claims is warranted, and an updated search in all search classes relevant thereto would appear mandatory under Rule 104, and is hereby requested for this additional reason.

Applicant notes the substantial breadth of interpretation of Applicant's claims being proffered by the examiner, which correspondingly enlarges claim scope in later infringement analysis of the file wrapper. However, the examiner has failed to afford due weight to specific features and cooperation of features which distinguish over the applied art.

Applicant traverses the omnibus rejection of claims 1-11 and 20 under Section 102(b) over Spencer.

Under MPEP practice, the examiner may interpret exceptionally broadly Applicant's claims, but that interpretation must be based on common meanings of ordinary words when read in light of the specification and based on one skilled in the art. This, the examiner has not done.

Claim 1 recites a stack of alternating sheets 10a,b having repeating diecuts 16 offset among the sheets.

What do these elements mean? Their meaning may be

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determined when read in light of the specification, and this the examiner has not done.

Indeed, the examiner expressly admits that "The examiner does not give specific weight to the openings being die cut ...," which is not permitted by the MPEP or any case law identified by the examiner; but is a clearly erroneous interpretation of Applicant's claims which do not recite either "openings" as used by the examiner or that such opening are being "die cut."

The examiner's express attempt in para. 3 to redefine terms in Applicant's claims for comparison with the applied reference introduces additional error to the rejection.

Applicant's claims are precisely written, have precise cooperation of elements, and are described in substantial detail in the specification from which their meanings must be obtained in accordance with MPEP 2173 et seq.

Fundamental to both independent claims 1 & 20 being rejected by the examiner is the recitation therein of "repeating diecuts" in alternating sheets.

What is a diecut?

The examiner appears to interpret this element as an "opening" in his cursory remarks, but Applicant's claims do not recite a mere "opening."

Note that the field of endeavor for the present invention is expressly presented in para. 1 in which the present invention relates "generally to stationery products, and, more specifically, to die cut sheets."

The porous laminate disclosed in Spencer is clearly not a stationery product, but, quite differently, is a laminate of stainless steel metal layers bonded together to provide an integral laminate.

Even the present examiner must recognize the substantially different art classes, and that this reference is not even found in the very search class presented in the restriction requirement.

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Why is this relevant?

Because, one skilled in the art of stationery products, including those products having die cut features, will understand that art, and the features therein, and the terms typically used therein with common understanding.

The examiner is duty bound to interpret claims in the relevant manner, and not divorced from the reality of the skilled artisan.

Note that "die cut" as used in para. 1 is a verb modified by a noun which in turn modify the noun-sheets. In this sentence construction the sheets are cut by a die to form the features thereof.

And in the stationery art, such die cutting is the quintessential manner of forming the various stationery products which differ from each other in fundamental part by the different locations of the diecuts themselves.

The ubiquitous label sheets commonly found in all business offices include the notoriously well known pressure sensitive labels whose perimeter is formed by die cutting the face sheet in which they are found, with the label having adhesive on its back side, and laminated to the release liner so that individual labels can be peeled away.

How is this relevant?

The relevancy is determined by the meaning given to terms of art by those skilled in the art.

What then is the meaning of a "diecut" as recited in the claims, as interpreted by one skilled in the art, and as interpreted by the examiner?

The examiner has appeared to interpret the recited diecut, not as one skilled in the art would, but as an examiner would do without regard to the mandates of the MPEP since the examiner has uncovered a nonanalogous reference for a stainless steel filter which has "openings" that the examiner attempts to shoe-horn into the present claims.

Note, quite fundamentally that the "diecut" as recited

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in all the claims is a noun, not a verb; and the examiner's contention that he "does not give specific weight to the openings as die cut" misinterprets the express claim language and is erroneous per se.

The examiner further opines that "it is not clear how hole formation by this means differs from hole formation by another means such as laser cutting." Of course, the examiner so states, because the present examiner has presented in para. 1 this very new example of "cutting with a laser" to bootstrap the restriction requirement made by the previous examiner.

Plain and simple logic clearly undermines this contention being made by the examiner to support insupportable restriction and rejection because how an element is made does indeed very well affect its configuration.

The examiner has overlooked the express teaching of Spencer at col. 3, ll. 48+, that the preferred method of making the porous laminate is "photoetching the desired slot patterns." And, of course, photoetching would result in slots having corresponding properties, which are not relevant to diecuts.

At lines 61-63, Spencer introduces the alternate method of "precision stamping" the lamina, which, yet again, would result in quite different properties of the lamina, and yet again not relevant to diecuts.

It is noted that neither Spencer nor the examiner have provided any evidence of how photoetching or stamping would be conducted, or what the resulting properties of the lamina would be, but those properties would necessarily be different by the very differences in the methods of formation. This is certain.

Adding to the errors of the rejection, the examiner merely opines without any logic or evidentiary support that the openings could be formed by "laser cutting."

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What is laser cutting, and what would the resulting properties be?

Where is any teaching in Spencer that the slots therein could be formed by laser cutting?

Laser cutting, of course, would appear to cut by melting or burning the substrate.

Col. 2, ll. 55+, of Spencer discloses that the lamina are 2 mil thick stainless steel metal with 3.5 mil slots and 10 mil strips necessarily requiring high accuracy for achieving the 26 per cent porosity.

Where is any logic or evidence or teaching that those thin stainless steel laminates could be cut by lasers with the requisite degree of precision, and without damaging those thin sheets by the melting heat of laser cutting?

Laser cutting would clearly result in a burned, jagged cut line, and the metal would have a heat affected zone at the cut line in which the material properties of the metal are degraded.

Is such a laser cut line the same as a photoetched line or a stamped line or a die cut line? Of course not.

And, suppose the slots 14 in Spencer were to be cut using the plain and simple metal hack saw? The examiner expressly fails to give any weight to how the slots 14 in Spencer are formed, so would the hack saw be within the teachings of Spencer?

Of course not. Why? Because the hack saw cut would be very jagged of course, and would lack the requisite precision when used to cut the 2 mil thick stainless steel laminates in Spencer.

The diecuts expressly recited in Applicant's claims must be given suitable meaning as would be given thereto by one skilled in the art when read in light of the specification, since the MPEP requires this. The examiner is not free to interpret the claim features in a subjective manner without regard to the various patent rules, nor is the examiner given

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license by the MPEP and Patent Rules to disregard express claim features, as he has done, both for bootstrapping the restriction requirement, and in now rejecting the claims under Section 102.

A rejection under Section 102 is highly technical and the examiner must show in a single reference the identical product being recited, with identical features, arranged in an identical manner, with identical function and properties.

Clearly, Spencer does not support the requisite identity of elements in the claims now being rejected by the examiner.

The examiner in rote fashion does not examine the Spencer reference in the whole, but simply refers to "abstract, Figure 1" as somehow being a basis to reject the claims, all claims 1-10 and 20 in toto, without explanation, or support in the MPEP.

As indicated above, claim 1 recites a stack of alternating sheets 10a,b having repeating diecuts 16 offset among the sheets.

Firstly, the recited diecuts 16 are clearly linear slits formed in the sheets 10 by the cutting edges or knives 24 as described in the specification, and for which one skilled in the art would well recognize in meaning. Diecuts are clearly not the relatively wide "openings" made by the photoetching method in Spencer.

The very problem being solved by the Applicant is also presented in the background section that such diecuts when stacked in alignment provide local interruptions in the smooth continuity of the sheets which can lead to the jamming and skewing problems when fed in a printer.

The diecuts 16 recited in Applicant's claims have no counterpart in the Spencer reference.

Spencer is quite clear in its description of the "series of uniform width parallel slots 14" shown in the figure 1 embodiment being used by the examiner.

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Of course, the examiner's admitted failure to give "specific weight" to how the "openings" 14 of Spencer are formed is clearly erroneous because those openings are wide "slots," clearly not diecuts; and col. 3 of Spencer clearly teaches that they are formed by photoetching or stamping.

But this teaching of Spencer is not relevant to Applicant's claims, which recite not wide slots, but diecuts, which by nature and definition and use in the stationery art field of endeavor are linear slits severed in the face sheet by the correspondingly thin die cutting knives.

This would be notoriously well known to one skilled in the art of stationery products including diecuts therein. And, even a cursory search by the examiner in relevant search classes within the scope of the present examiner's art unit 1772 and pertaining to die cut stationery products would indeed uncover a plethora of references specific to die cut products from which the meaning of diecuts will become apparent.

The examiner's failure to search in relevant stationery art classes cannot form a basis to reject Applicant's claims specifically relating to stationery products.

Yet, the examiner has afforded no weight, let alone due weight, to the express features of Applicant's claims, rendering without merit all of the rejections thereof as based on an erroneous and unwarranted interpretation of the claims.

Applicant's claims have even more differences over Spencer.

Independent claims 1 & 20 further recite alternating sheets having repeating diecuts 16.

What does this mean, and what weight, if any, has the examiner provided?

"Repeating" has its ordinary definition when read in light of the specification, and means that the diecuts 16 repeat in the stack of sheets, and this is due to the common

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method of manufacturing stationery products from continuous webs well known to those skilled in the art, but intentionally disregarded by the examiner in the rote assertion of "non-web form" of manufacturing.

One skilled in the art of stationery manufacturing clearly does not employ "laser cutting" to manufacture stationery products, nor to laser cut "diecuts" as the examiner contends, and the examiner has not shown otherwise, nor provided any evidence to support the bald contention.

It is quite conspicuous in para. 3 of the office action that the examiner has not used the word "repeating" in those comments, and therefore has failed to afford any weight thereto.

This is clear error since each and every feature recited in each and every claim must be afforded due weight by the examiner, and those features must be found in a single reference in the same combination, clearly overlooked by the examiner in the rush to reject the claims, and clearly not found in Spencer.

Note the various forms of Applicant's diecuts 16 shown in figure 2 which repeat from sheet to sheet, A to B to A to B, etc, when manufactured from the continuous web.

Note the stacking of the sheets in figure 3 and how the same diecuts 16 repeat in each of the stacked sheets.

This is in contrast with the figure 1 embodiment of Spencer as used by the examiner.

Note that the openings 14 do not repeat in the lamina 12, but intentionally and expressly do not repeat so that the special cross section shown in figure 2 may be obtained. Note further that the slots 14 change configuration from sheet to sheet, and intentionally do not repeat.

At col. 2, ll. 35+, Spencer discloses that the "slots 14 overlap and extend transversely to the slots of each of adjacent lamina," with crossing angles from 15 to 90 degrees.

In other words, the slots 14 do not repeat, but have

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different configurations from lamina to lamina.

Claims 1 & 20 yet further recite that the repeating diecuts 16 in the alternating sheets are offset from each other, and the specification explains the substantial benefit of this feature which prevents direct alignment of the repeating diecuts, which without such offset the repeating diecuts would be exactly aligned with each other leading to the jamming and skewing problem when used in the printer.

In para. 3, the examiner merely opines that the "openings being offset between alternate layers of the stack," without evidentiary support, and neither the "Abstract" nor "Figure 1" indicate otherwise.

Figure 1 of Spencer appears to show one lamina 12 with the slots 14 being parallel to each other at a diagonal orientation of about 45 degrees, and the next lamina having the slots oriented at minus 45 degrees, and normal (90 degrees) to the previous lamina 12.

The adjacent lamina 12 appear to position the slots 14 in direct overlap with each other, without any offset whatsoever in the location of the slots. It is only the 45 degree different orientation of the slots 45 which forms the intended circuitous flowpath shown in the figure 2 cross section.

Claims 1 & 20 recite a very special cooperation of features including the "repeating diecuts offset" in the alternating sheets having no counterpart in Spencer.

The slots 14 in Spencer are not diecuts, those slots do not repeat in the alternating sheets, and those slots are not offset in the manner recited in Applicant's claims.

Claim 20 further recites that the previously recited repeating diecuts 16 are both offset from the perimeters of the alternating sheets (see figure 3 for the significance of this feature), and aligned with each other in a next successive sheet.

This combination the examiner has also overlooked.

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Figures 1 & 2 of Spencer clearly illustrate, and Spencer so discloses, that the slots 14 are bounded by identical solid areas 18 from lamina 12 to lamina 12, and therefore there can be no offset from those perimeters in the manner recited in claim 20.

In figure 1 of Spencer, the slots 14 are oriented 90 degrees different from lamina to lamina and therefore do not repeat from lamina to lamina

In figure 2 of Spencer, the slots 14 have different orientations between the five lamina shown, and the examiner has not shown how the same slots 14 are both offset in adjoining sheets and aligned with each other in a next successive sheet.

Spencer discloses many geometrical features of the slots 14, but those slots are clearly not diecuts as used in Applicant's claims, as described and defined in the specification, and as would be interpreted by one skilled in the art, and the examiner has not shown otherwise.

It is quite conspicuous that the very reference Spencer being applied by the examiner does not refer to the wide slots 14 as "diecuts," and equally conspicuous is the examiner's failure to search the plethora of relevant prior art in the stationery art classes of which the present claims pertain, and in which classes the examiner would indeed find a multitude of references that disclose die cuts in various forms as would be understood by one skilled in the art.

Rule 104 mandates thorough searching and that searching will provide ample evidence of the meaning of die-made cuts to those skilled in the art, and would provide ample evidence of the fundamentally different nature of the porous laminate disclosed in Spencer having no relevance to stationery products.

Claims 2-8 have been overlooked by the examiner in his cursory remarks presented in para. 3, and therefore the examiner has failed to establish any showing to support their

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rejection.

Claim 2 recites identical configurations of the sheets, and clearly the slots 14 in Spencer are not diecuts nor do they have identical configurations as plainly shown in figures 1 & 2, as well as in figures 3 & 4.

Claim 3 recites that the repeating diecuts 16 have different offsets from the perimeters.

Spencer is clear in the teaching of the identical solid areas 18 and the identical spacing of the slots 14 therefrom.

Claim 4 recites the repeating diecuts 16 offset laterally from each other.

The slots 14 in Spencer do not repeat with lateral offset in this manner in view of their wide openings and 90 degree orientations.

Claim 5 recites that the repeating diecuts 16 are offset from each other and aligned with each other in a next successive sheet.

In figure 2 of Spencer, the slots 14 have different orientations between the five lamina shown, and the examiner has not shown how the same slots 14 are both offset in adjoining sheets and aligned with each other in a next successive sheet.

Claim 6 recites that the different offsets repeat in successive sheets.

See figure 2 of Spencer which shows different orientations in the five lamina shown.

Claim 7 recites patterns of diecuts 16 offset from each other between the sheets.

The patterns of slots 14 shown in figure 1 of Spencer share the common solid area 18 and have no offset from each other, and share identical spacing from the perimeter of that area 18.

Claim 8 recites that the patterns are offset laterally from each other, yet the slots 14 in Spencer share the identical solid area 18 without offset from the perimeter

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thereof.

Claim 9 recites that the pattern includes an arcuate diecut 16a and a straight diecut 16b,c spaced laterally apart.

The examiner's added use of figure 4 supplants the examiner's use of figure 1, and fails to support the rejection of the previous claims from which claim 9 depends.

Figure 4 is a different embodiment, yet again including wide slots 14 which are clearly not diecuts.

Figure 4 fails to disclose repeating diecuts offset among alternating sheets in the manner recited in claims 1, 2, 3, 7, and 8, from which claim 9 depends.

Note, yet again, the common solid border shown in figure 4 of Spencer and the identical spacing of the slots 14 from the perimeter thereof.

The slots 14 shown in figure 4 of Spencer are unitary elements as previously used by the examiner for the figure 1 species, and the straight or curved portions thereof do not match the combination of features recited in claim 9, and the examiner has not shown otherwise.

The dependent claims include combinations of features overlooked by the examiner in the rush to reject using such a disparate reference as Spencer, being greatly distorted in interpretation to try to fit where it does not fit.

The examiner looks to naked features of Applicant's claims divorced from the whole in the hindsight (re)interpretation thereof to fit Spencer, when Spencer does not fit.

Spencer does not disclose either arcuate diecuts nor straight diecuts, and the examiner's use of the wide slots 14 thereof is without legal support. And, Spencer does not disclose the lateral spacing of such different diecuts in the diecut patterns also recited in their geometric combination.

Claim 10 recites that each of the diecut patterns further includes a pair of straight diecuts 16b,c defining a

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band 26 spaced laterally from the arcuate diecut 16a.

This claim has also been overlooked by the examiner in the cursory rejection. The portions of the slots 14 in Spencer do not read on the distinct diecuts recited in claim 10, and do not meet the geometric combination found in that claim, and the examiner has not shown otherwise.

Spencer is clearly not relevant, and the examiner's attempt to use that reference becomes more and more distorted and more and more untenable as features are added in the dependent claims, without any regard, let alone due regard by the examiner.

Claim 11 recites that the diecut patterns are offset laterally from each other from sheet to sheet.

Clearly, the pattern of slots 14 in figure 4 of Spencer do not comprise diecuts, nor are they offset laterally from each other between the sheets, when to the contrary the slots 14 are wide and expressly aligned with each other for the requisite overlap needed to form the porous laminate.

Accordingly, withdrawal of the rejection of claims 1-11 and 20 under Section 102(b) over Spencer is warranted and is requested.

Applicant traverses the rejection of claims 1-9, 11-12, and 20 under Section 102(b) over May.

The examiner's 5-line contentions in para. 4 fail to address the many claims listed under this rejection; and are clearly erroneous; and further admit the failure that "No specific weight is given to the method of hole formation noted above."

None of the elements listed by the examiner in para. 3 have any relevant correspondence with any features in Applicant's claims, and the examiner's contentions only leave to speculation what grounds are being used to support this rejection.

Fundamentally, independent claims 1 & 20 recite a stack of sheets having repeating diecuts, and "See Figure 3" of May

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clearly does not illustrate any stack whatsoever.

In figure 3, May plainly illustrates three dividers 10 standing vertically and spaced apart from each other. This is clearly not a stack.

The examiner identifies the "holes" in May, but how are these holes relevant to Applicant's claims, which recite diecuts, not "holes?"

The examiner also addresses "offset holes" in May, but where are these elements disclosed?

The examiner identifies "straight die cuts" in May, but where are these disclosed?

Figures 1 & 2 of May show in great detail one of the dividers 10 shown in figure 3.

The only holes shown in figures 1 & 3 of May are the apertures 30, but those apertures are round, and are clearly not diecuts.

The "straight" elements shown in May include the indentations 27, 28, and 29 formed by stamping or scoring; yet the examiner provides no evidence that such indentations are diecuts in any definition thereof.

Note that the indentations 27,28,29 are formed on one side only of the dividers, and define corresponding ridges 27a,28a,29a on the opposite side of the dividers. And, the examiner has failed to show that those ridges correspond with diecuts in any definition of that element.

Note further, that in the Figure 3 arrangement of the three dividers 10 the visible lines and holes do not repeat from sheet to sheet but present any intentionally non-repeating pattern as disclosed in May. See, in particular, that the middle divider 10 shown in figure 3 does not match the other two dividers, and the corresponding features of that middle divider are not repeated from those other two dividers.

Claims 1 & 20 require both repetition of the diecuts and offset, and the dividers 10 in May lack this very special

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combination of both features, and the examiner's bald contentions do not support otherwise.

Furthermore, the examiner's 5-line contentions fail to address the various combinations in the various claims being rejected, and require unwarranted speculation.

Claim 2 recites identical configurations except for the offset; yet figure 3 of May clearly shows quite different configurations between the middle divider 10 and the other two dividers.

Claims 3 and 20 recite the different offsets of the diecuts from the respective perimeters; whereas figure 3 of May appears to show the same spacing of the various elements from the respective perimeters.

Claim 4 recites lateral offset among the repeating diecuts; yet the visible elements in figure 3 of May clearly do not repeat in the middle divider, nor are they laterally offset.

Claim 5 recites offset of the repeating diecuts in adjoining sheets; and figure 3 of May shows different, non-repeating elements without corresponding offset in the middle divider between the two other dividers shown.

Claim 6 recites that the different offsets repeat, yet no such configuration is shown in the solitary three dividers shown in figure 3 of May.

Claim 7 recites offset repeating diecut patterns, yet the patterns of elements in the middle divider 10 shown in figure 3 clearly does not repeat with the patterns of elements in the other two dividers shown, and lack the recited offset.

Claim 8 recites lateral offset of the diecut patterns, yet again lacking in figure 3 of May in which the middle divider is differently configured.

Claim 9 recites laterally spaced arcuate and straight diecuts lacking in figure 3 of May. The examiner's contention of "straight die cuts" is not supported by any

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identified evidence in May, since there are no diecuts shown at all in the illustrated patterns of elements. The "circular holes" in May are not diecuts nor repeat since the middle divider 10 is clearly quite different than the other two dividers, and lacks the requisite repetition of features.

Claim 11 recites lateral offset of the patterns; yet the patterns of elements in figure 3 of May lack corresponding offset since the middle divider is quite different than the other two dividers.

Claim 12 recites location of the repeating diecut pattern in the center page, whereas the middle divider 10 in figure 3 of May is clearly different than the other two dividers.

The examiner has chosen to reject these claims under Section 102, which mandates identity of elements, identity of cooperation, and identity of function clearly lacking in the dividers 10 of May.

The examiner's cursory description of the elements of May fails to identify corresponding elements, and leaves to speculation the intended meaning.

The examiner has not identified any evidentiary support in May for any special meaning that the examiner may be attempting to ascribe to the elements therein or the cooperation thereof, rendering unsupported the highly technical rejection of these various claims under Section 102.

Accordingly, withdrawal of the omnibus rejection of claims 1-9, 11-12, and 20 under Section 102(b) over May is warranted and is requested.

Applicant traverses the rejection of claims 9-12 under Section 103(a) over Applicant's paras. 5 & 9 and May.

The examiner merely compounds the errors of rejection by now failing to comply with the specificity requirements of MPEP 706.02(j) and the legal motivation requirements of Ch. 2100 in presenting a rote assertion of obviousness without

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any regard to claim language, the whole of those claims, or the whole of reference May.

May is clearly nonanalogous art and has no relevance whatsoever to Applicant's claims.

Para. 1 of the specification expressly identifies the field of endeavor as stationery products including those containing diecuts.

Col. 1 of May expressly identifies the field of endeavor as divider sheets for stacked products, like beverage containers; which is clearly not the same as stationery products.

Indeed, the previous examiner has determined that the relevant search class is 428/137; the present examiner has confirmed this search class, yet the May reference is identified by the present examiner in search class 271/1, which is clear evidence of the fishing expedition for references without due regard to the Manual of Classification, or even the restriction requirement itself.

The problem confronting the present Applicant is expressly presented in para. 5 wherein the diecuts in a stack of identical sheets define very special local interruptions which can snag together adjacent sheets in the stack during feeding in a printer.

Note, that the Background uses the express "diecut" feature as recited in the claims for the same structure; yet the examiner attempts to selectively pick from that very para. 5 of Applicant's own specification only the exemplary commercial application to the conspicuous exclusion of the stacked "diecuts" which cause the very problem being solved.

The problems in May are presented in cols. 1 & 2 and specifically include the interaction of the retaining bars in the supply magazine, and the vacuum effect; neither of which problems are relevant to the aligned diecuts in Applicant's specification.

Of course, the examiner may attempt to either

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recharacterize the field of endeavor or problems in May, but this is not permitted by the MPEP or case law.

As for the examiner's contentions presented in para. 6, such contentions are fundamentally illogical, and have no nexus with claims 9-12 being rejected under Section 103, and address the introduction of "air" having no relevancy to Applicant's problems or the combinations being recited in claims 9-12.

Furthermore, the examiner's contention of "openings" has no counterpart in Paras. 5 & 9, or in claims 9-12 which do not recite any "openings" whatsoever, nor has the examiner shown that any "openings" in May correspond with the diecuts in Applicant's claims which are being offset to solve the snagging problem, when the "openings" in May clearly do not present any such snagging problem, and the examiner has not shown otherwise.

The fundamental teachings of May are not the "openings" disclosed therein divorced from reality; but that the dividers 10 are arranged with indentations 27,28,29, ridges 27a,28a,29a, and cooperating apertures 30, and the middle divider 10 in figure 3 is not a repetition of the two end dividers, but intentionally differently configured to solve the retaining bar and vacuum problems.

None of this teaching in May is relevant to the commercial application being used by the examiner; none, and the examiner has not shown otherwise in the rush to reject even each and every one of the dependent claims notwithstanding the additional combinations of features recited therein.

Claim 9 not only recites that the repeating diecut pattern includes an arcuate diecut spaced from a straight diecut, but that the repeating patterns are offset from each other and offset differently from the respective perimeters.

The examiner has clearly overlooked this combination of features in attempting to combine May without regard to the

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fundamental teachings thereof; instead with the surgical precision of classical hindsight the examiner refers to the "openings in the stacked sheets to allow entry of air and preventing jamming when printing..." in some unexplained combination with paras. 5 & 9.

There are no "openings" in the commercial application being used by the examiner, only diecuts.

And, the "openings" in May are clearly not diecuts nor do they have any relevance to "printing" as the examiner contends, since there is no printing being effected in May.

And, those "openings" in May do not function alone, but in combination with the indentations and ridges having no counterpart in the commercial application being used by the examiner.

The examiner simply contends that it would have been obvious to select only the "openings" in May and somehow combine them with the commercial application to admit air to prevent jamming when this is clearly not based on legal motivation, only rote examiner argument, without any discernible logic.

Claim 10 further recites the pair of diecuts and arcuate diecut having no counterpart in May, nor relevance with the indentations, ridges, or "openings" therein, and the examiner's cursory comments do not show otherwise.

Claim 11 further recites that the diecut patterns are both offset laterally from each other and at different offsets from the respective perimeters.

The commercial application being used by the examiner has expressly aligned diecuts which cause the very snagging problem being solved by the Applicant. Such snagging is not a problem in May; instead, the retaining bars and vacuum effect are. The basic teaching of May is not the isolated use of the apertures 30 therein divorced from reality, but the different configurations of the dividers shown in figure 3, and the cooperation of those apertures with the

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indentations and ridges as well explained in May.

The examiner must, and has, disregarded the fundamental teachings, and the whole of May in the blind rush to reject the claims without evidence, without basic logic, and without complying with the stringent requirements of the MPEP, including the legal motivation requirements of ch. 2100.

And, claim 12 further recites the location of the repeating diecut pattern in the center page, but also offset to solve the snagging problem.

The examiner's use of the commercial application fails to address the fundamentally different configuration of that commercial application and the dividers 10 of May, and the fundamentally different use. The middle divider shown in figure 3 of May as used by the examiner clearly has a different and non-repeating pattern of its elements with the other two dividers; and lacks any diecuts in the manner recited in claim 12, or any other claim.

Accordingly, withdrawal of the rejection of claims 9-12 under Section 103(a) over Applicant's paras. 5 & 9 and May is warranted and is requested.

In view of the remarkably broad interpretation of Applicant's claims and the references being proffered by the examiner, Applicant has chosen to amend claims 3 and 20 to test the extent of that interpretation, and further enlarge the scope of the claims in later infringement analysis.

In particular, claims 3 and 20 have been amended to emphasize the composition of the sheets as stationery sheets which are neither the stainless steel metal sheets of Spencer, nor the package dividers 10 of May.

Claims 3 and 20 have also been amended to emphasize the loose stack of sheets which are not bonded together in the integral manner of the porous laminate of Spencer.

The background in paras. 1-10 introduces the stationery sheets arranged in a loose stack; and the improved features thereof are introduced in paras. 17 & 18 of the

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specification.

The recited stacks of sheets are stationery products configured for travel through the typical printer, and are loosely stacked without being integrally bonded together.

Claims 3 and 20 have also been amended to emphasize the slit feature of the diecuts which has the special configuration inherently formed during the die cutting introduction thereof in the sheets, as disclosed in the Background section and at paras. 21 & 21; and neither the wide slots in Spencer nor the openings or indentations or ridges in May have any relevance to such diecuts.

And, claim 20 has been additionally amended to emphasize the different offset from the perimeters of the repeating diecuts as disclosed at para. 24.

The solid areas 18 in Spencer are identical from sheet to sheet without different offset from the pattern of slots 14 bound thereby.

The border surrounding the indentations, ridges, and apertures in May also appears identical from sheet to sheet, without different offset from the patterns thereof.

Further in view of the fundamental shortcomings of the applied references, Applicant has chosen to add claims 21-25 to recite further species of the Group I invention, which claims 21-25 are hereby added to the provisional election of claims.

Independent claim 21 recites the species of sheet stacks originally recited in independent claims 1 & 20 in which the sheets have identical configurations and diecuts except for offset of the diecuts to prevent overlap of the diecuts between adjacent sheets.

The specification discloses at various locations, including paras. 19, 28, 29, 31, 32, 35, and 43 for example, and the drawings illustrate the identical nature of the stacked sheets, different simply in the offset of the repeating diecuts to prevent overlap or interlock thereof,

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and solve the snagging problem.

As indicated above, the laminates 10 in Spencer are clearly not identical from sheet to sheet with identical slots 14 offset to prevent overlap thereof. Note, the fundamental requirement in Spencer for intentional overlap of the laminates and slots to effect the intended porosity, shown in section in figure 2.

In May, the dividers shown in figure 3 are clearly not identical in configuration, nor do they have identical elements therein. And, the various elements therein appear to overlap as disclosed by May for the requisite efficacy.

Claim 22 recites that the sheets have identical patterns of multiple diecuts in each sheet offset from each other in the adjacent sheets to prevent overlap of the multiple diecuts between the adjacent sheets. Claim 22 corresponds with features introduced in claim 7 and disclosed at paras. 31 & 32 for example.

The patterns of slots 14 in Spencer are clearly not identical, and clearly overlap from sheet to sheet.

The patterns of elements in May are clearly not identical between the middle and end dividers shown in figure 3, and intentionally overlap.

Claim 23 recites that the diecut patterns are offset differently from respective perimeters of the adjacent sheets, and corresponds with features introduced in claims 3 & 8 and disclosed at para 30, for example.

The borders surrounding the internal features in both Spencer and May appear quite uniform from sheet to sheet.

Claim 24 recites that the different offset is practically imperceptible as disclosed at paras 32, 42, and 47, for example, and can be about 6 mm for example, or smaller, subject to the manufacturing tolerances.

There is clearly no offset between the internal features and the surrounding borders in Spencer and May, let alone an imperceptible, but finite, offset.

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Claim 25 recites the center page features originally recited in claim 12, with identical configurations and diecuts offset as also recited.

The dividers disclosed in May clearly have different configurations between the middle and end dividers shown in figure 3; and the commercial application found in Applicant's Background section has aligned and overlapping diecuts which present the very problem being solved.

Accordingly, the species stacks recited in claims 21-25 well distinguish over the applied art, which art is clearly not analogous thereto, nor relevant.

In accordance with the duty imposed by 37 CFR 1.104 and MPEP sections 707, 707.05, 707.07, and 707.07(g), the examiner is requested to reconsider not only the art of record, but also update the prior art search to uncover additional references specifically related to stationery products and diecuts therein, to ensure full compliance with the required thoroughness of examination.

In re Portola Packaging, Inc., 42 USPQ2d 1295 (Fed. Cir. 1997) emphasizes the importance of complying with this duty to ensure that all references of record have been fully considered by the examiner in the various combinations thereof. And, the Board of Appeals has further elaborated on the importance of this examiner duty in Ex parte Schricker, 56 USPQ2d 1723 (B.P.A.I. 2000).

In view of the above remarks, allowance of claims 1-12 and 20; and added claims 21-25, over the art of record is warranted and is requested.

And, withdrawal of the restriction requirement is further warranted and requested; and method claims 13-19 should now be rejoined, and the prior art search updated specifically therefor, along with due examination of these method claims as well.

Those method claims 13-19 are well distinguishable over the references Spencer and May of record, which clearly

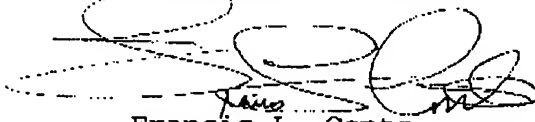
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provide no teaching of any related method of making or method of using.

Allowance of method claims 13-19 is also warranted and is requested.

Please charge the required fee for added claims 21-25, and any deficiency associated with this amendment, to Deposit Account No. 14-0225 of NCR Corporation in accordance with the attached Fee Transmittal.

Respectfully submitted,



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Attachment: One-page Fee Transmittal for FY 2005